

REMARKS**1. Claim Status**

No claims are canceled, added, or amended, leaving claims 34, 36-45 and 50 in the application.

2. Sections I-II of the Office Action: Rejection of Claims 34, 36-45, and 50 under 35 USC §102 in view of U.S. Patent 5,366,664 to Varadan et al.

Kindly reconsider and withdraw these rejections, since *Varadan* does not in fact teach the claimed invention, nor would it suggest the claimed invention to one of ordinary skill. The rejections allege that *Varadan* fully teaches the claimed lithographic ink, including teaching an ink including a polyamide resin (a "thermoplastic polymer matrix material") at column 3 lines 36-49 (specifically at column 3 line 43), and an organic solvent at column 6 lines 8-14. However, *Varadan* does not teach or suggest inks having *both* of these components; rather, *Varadan* teaches electromagnetically-shielding (EMS) compositions wherein *one* of these components is used, but not *both* at the same time, and therefore these compositions do not meet independent claims 34 and 50.

Initially note that *Varadan*'s EMS matrix is described at column 2 lines 18-22 as being formed of silicone oils/waxes, *or* of polymers/plastics; see also column 2 line 50 onward. As noted at column 2 line 50-column 3 line 3, the silicone compounds are described as being useful when a "pliable caulking or putty-like material" is desired (column 2 line 57). As then discussed at column 3 line 4-column 3 line 68, the various polymer/plastic materials are desired when more solid/rigid materials are desired. Specifically, *Varadan* describes use of polyamides as "preferred plastic polymers" which "can be molded, foamed, extruded or otherwise shaped into various structures and articles" at column 3 lines 41-51 (with polyamides specifically noted at line 43); see also column 3 lines 38-40 (discussing use in "rigid sheet material, cabinetry or housings for electronic devices such as computers, circuit protectors and the like"). In other words, the polyamides are used by *Varadan* when making an EMS material which is formed into a solid/rigid object, and silicones are used by *Varadan* when making a moldable/fluid EMS material.

Varadan then discusses the use of organic solvents in the composition *when a flowable composition is desired*. See, for example, column 6 lines 8-13, which discuss use of the organic solvent when preparing the EMS composition as “dispersions which may then be painted or sprayed onto suitable substrates such as metal, glass, plastic or electronic components to provide electromagnetic shielding for such substrates.” In other words, the organic solvents are used when a fluid (paintable or sprayable) EMS composition is desired. In this case, the silicone-based matrix is used as the base material for the composition; see column 6 lines 2-23. In contrast, where a solid/rigid EMS composition is desired, the polyamide resins are used (and the organic solvent is not used), as discussed above. Thus, *Varadan* does not in fact teach the use of a polyamide matrix with an organic solvent as recited by independent claims 34 and 50.

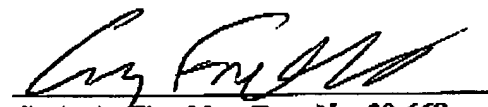
Varadan also plainly does not suggest that a rigid polyamide matrix ever be used with an organic solvent because the goals of the two components – polyamide to impart rigidity, and solvent to impart flowability – are plainly contrary to each other. In similar respects, *Varadan* also does not suggest that a rigid polyamide matrix ever be used with a flexible silicone-based matrix (to which solvent might be added). See, e.g., the table in column 5, showing that when caulk/putty or other flowable compositions are desired, the “silicone matrix oil” is used *without* any “polymeric matrix,” whereas if solid “sheet/gasket” material is desired, the “polymeric matrix” is used *without* any “silicone matrix oil.”

Thus, given that the organic solvent is present in *Varadan*’s EMS-shielding composition only when the silicone-based matrix is used to make a flowable composition, and *Varadan* then uses a polyamide resin (without the organic solvent) when a rigid composition is desired, *Varadan* does not teach the composition recited in claims 34 and 50, which require use of *both* a polyamide resin and an organic solvent. “To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim” (*Brown v. 3M*, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001)). Further, *Varadan* does not in any way suggest that these two components should be used together: *Varadan* uses the polyamide when rigidity is desired, and uses the organic solvent when fluidity is desired, and there is no suggestion or reason

why the two would be used together: their purposes (rigidity and fluidity) are in conflict.

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



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ATTACHMENTS:

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